

**REMARKS**

**A. Claim 8 was amended in view of the objection set forth in paragraph 5 on page 2 of the Office action.**

The foregoing amendment is believed to correct claim 8. Accordingly, entry of the Amendment is respectfully requested.

**B. Claims 1-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Pond et al. (US 5,886,690). The applicant respectfully traverses this rejection for the following reason(s).**

Pond et al. (*hereafter* : Pond) fails to anticipate the claims as originally filed and further fails to anticipate the claims as amended, the amendment being made in view of the objections raised in paragraphs 1 and 2 on page 2 of the Office action.

Note that in order for an anticipation rejection to be proper, the anticipating reference must disclose exactly what is claimed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Note here that the Examiner has not relied on "inherency," accordingly, each and every element must be expressly described in Pond.

Claims 1, for example, calls for *an input unit for inputting a display command for displaying a sub-list having a predetermined number of files selected in an entire list of the files recorded in a recording medium.*

Here, the Examiner refers to Pond's col. 5, lines 22-40, Fig. 2 and Fig. 5. Note also that the Examiner erroneously equates Pond's "channels" with the claimed *files*.

Col. 5, lines 22-40 state: "Under another selected embodiment of the present invention, remote control unit 18 includes PAGE key 40 can be used to display a screen that allows the user to "page" forward, backward, up and down through various screens in a "page" mode. According to one aspect of the "page" mode, the up and down arrow keys will display only a selected subset of the available channels (i.e., ten (10) channels at a time) and the program screen guide includes a page bar for identifying the presence of any selectable program channels that are not present on the currently displayed channel bar. According to a separate aspect of the "page" mode when it is used while in the "Open Mode," the left and right arrow keys advance by a predetermined time interval (i.e., one day intervals) the portion of the available program schedule information that is displayed and the program screen guide includes a page bar for identifying the presence of any time-dependent program information for the program channels that is not presently shown on the program screen guide."

A review of the foregoing finds no mention of *an entire list of the files recorded in a recording medium*, and the Examiner has failed to identify where *a recording medium* is disclosed in Pond for recording Pond's "channels."

Looking further into the rejection, we find that the Examiner, on page 6, paragraph 16, with respect to claim 14, refers to Pond's ROM as the means for storing the *entire list* and further refers to Pond's RAM. We will address claim 14 later. As for now, we look back to claim 1 and read into the rejection reference to Pond's ROM or RAM as the claimed *recording medium*. The Examiner has made no mention of any other recording medium.

Looking to Pond's disclosure, we find, with respect to Fig. 10, the disclosed ROM and RAM. Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20.

Accordingly, ROM 351 stores only " object code software;" and being a read only memory can not store the "channel" information disclosed in Pond. That leaves us with RAM 348 to consider. Looking further to Pond's disclosure, we find no other mention of RAM 348 nor to what type of "data" that is stored therein.

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Accordingly, the rejection of claim 1 is in error, because Pond fails to disclose, and thus anticipate, at least the claimed *entire list of the files recorded in a recording medium*. Thus the rejection should be withdrawn.

Looking again to the written rejection of claim 1, the Examiner states that Pond "teaches", instead of Pond discloses. A §102 rejection must be based on disclosure.

"There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991).

The Examiner further states that Pond teaches a "sub-list created from downloading, to memory storage hardware, a list of available channels . . . and associated programs . . . from an appropriate source." We note that the Examiner's arguments (page 10 paragraph 30) in response to the Applicant's traversal are not too different from the language used in the written rejection.

It is respectfully requested that the Examiner identify where this **memory storage hardware** is **disclosed** in Pond. The Examiner is further requested to identify where Pond discloses **an appropriate source**.

On page 10, paragraph 30, the Examiner goes on to state "Pond teaches the entire list stored [at] a remote location and portions of the entire list being downloaded, as needed, to memory at the users receiver." The Examiner uses nearly identical language in paragraph 32.

It is well known in the art, see U.S. Patent No. 5,479,268 to Patrick Young et al. incorporated by reference in Pond, that a broadcast source provides schedule information on the vertical blanking interval (VBI) of a broadcast video signal. A detector/decoder separates this information and processes it for display in response to a request by a user (viewer), otherwise it remains on the VBI

and is ignored by the television system.

**The schedule information is a single file**, not a plurality of files, containing data pertaining to every channel available from the broadcast source (such as a local television company like Comcast or Cox). That is, the information is **not** broken down into a plurality of files with each file being sent on a separate VBI.

The schedule information is decoded and displayed in response to the user request (e.g., displayed in the formats disclosed by Pond).

Young et al. discloses:

In the system 180, programmable tuner 202, which may be part of a cable decoder unit, receives a TV signal from antenna 200 and/or from cable input 205. Tuner output 216 goes to a vertical blanking interval (VBI) decoder 222, which may be a closed caption decoder or a high speed teletext decoder. **Listing** information and other support information, such as cable channel assignment data, will be transmitted over the VBI by one or more local stations or cable channels several times a day or continuously.

When update is required, programmable tuner 202 will be tuned automatically to the station or cable channel carrying the data. After the VBI signal is processed by CPU 228, the **listing** data is stored in schedule memory 232.

For a What's on TV request, **the listing** stored in schedule memory 232 is retrieved, processed by CPU 228, and outputted to video display generator 224. Video switcher 226 is enabled by CPU output 246 to select the video display generator 224 output whenever schedule data is to be presented to the TV/monitor 210.

The listing is **not** a plurality of files, but is instead a single file, similar to the file saved used to generate the Examiner's rejection. Consider the rejection. The file data, once recalled by the

Examiner, is decoded by a word processor and displayed on a screen. If the information is formatted in such a way as being unable to display the entire file on a screen, the information is separated into display pages. Accordingly, the screen display may show, for example, part of a page, a whole page or two whole pages. These pages are **not** separate files, and are not a sub-list of plural files.

Likewise, in Pond, the channel information is part of a single file located on the VBI of a video signal, decoded and stored in a schedule memory. If the information is formatted in such a way as being unable to display the entire schedule on a screen, the schedule is separated in display pages.

Pond discloses:

As shown in FIGS. 5 and 6, the "Page Mode" can be used when the program guide screen 50 is in "Open Mode," and can also be used when the program guide screen 51 is in "Closed Mode." According to one embodiment of the present invention, when the program guide is in "Page Mode," the program guide screen 70 includes a page bar 72 as shown in FIG. 5. According to a separate embodiment of the present invention in which the guide screen is in "Open Mode," the program guide screen 70 includes a page bar 71 for indicating the presence of any program channel information (such as time-dependent program information) that is not shown on the currently displayed program screen guide. As will be appreciated by those skilled in the art, the page bars 71, 72 visually convey to the user information about the position of the currently displayed page relative to the total pages available for viewing. For example, a vertical bar along the side of the program guide screen may include a segment that is highlighted or otherwise visually distinct from the remainder of the bar, and the position of this highlighted portion relative to the remainder of the bar indicates how many additional pages of channel information are available for viewing. Alternatively, the page bar 72 may provide an alphanumeric indication of which page is being viewed (i.e., "page 1 of 6" or "1/6"). As shown in connection with FIG. 6, a page bar 72 can also be used in connection with the "Closed Mode" operation to provide a visual or alphanumeric indication next to the channel bar 54.

There is no disclosure supporting any holding that these pages are separate files, nor is there

any disclosure supporting any holding that each channel is stored in memory as separate or individual files.

The Examiner repeatedly refers to Pond's col. 5, lines 22-40; col. 6, lines 3-10, col. 7, lines 21-28 and Figs. 2 and 5.

Col. 5, lines 22-40 refer to the paging operation controlled by a remote control.

Col. 6, lines 3-10 refer to the determination of available channels from a broadcast source. Such determination is well known in the art. When a user purchases a new television and connects it to a tv cable input from a broadcast source (such a Comcast or Cox), there is a menu option to automatically detect available channels in order to set up the receiver's tuner. If the tuner can receive 124 channels, but there are only 99 channels available that contain video information, the automatic setup blocks the use of channels that do not carry video. Accordingly, if channels 100-124 are blocked then when a user of a remote scrolling through the channels reaches 99, the next channel to be displayed in response to a channel up command will start again a 1, skipping channels 100-124.

Col. 7, lines 21-28 discuss "any required memory hardware" and where such hardware may be located.

None of the sections of Pond referred to by the Examiner, *displaying a sub-list **having a predetermined number of files selected in an entire list of the files recorded in a recording medium;** nor **creating one or more sub-lists from the entire list, each sub-list being different from the other sub-lists, and controlling the display unit to successively display each of the sub-lists through the display unit whenever the display command is input through the input unit.***

Accordingly, the rejection is deemed to be in error and should be withdrawn.

With respect to claim 10, it is required that Pond disclose a step of *reading an entire list of files recorded in a recording medium*. We find no factual reference to such a step being disclosed in Pond the rejection. The Examiner repeats the Applicant's claim language, identifies a portion of Pond's disclosure, *i.e.*, col. 5, lines 22-40, but fails to show where the above step is found in that portion of Pond's disclosure. Instead, the Examiner refers to a "control unit for inputting commands to display a sub-list, from the list of available channels." There is no indication that this "list of available channels" is entirely read, nor that this list is recorded in a recording medium.

Accordingly, the rejection of claim 10 is in error and should be withdrawn.

With respect to claim 14, it is required that Pond disclose *detecting all the files recorded on said vast-capacity recording medium*.

The Examiner equated Pond's ROM 351 with the claimed *vast-capacity recording medium*. We can find no disclosure in Pond that ROM 351 stores Pond's entire list of available channels, and the Examiner has not pointed to any location in Pond supporting the rejection. Note, *Ex parte Levy*, 17 USPQ2d 1461, 1462 (1990) states:

"it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."

We can only find that object code software is stored in the read only memory (ROM) 351.

Claim 14 also calls for *storing a list of said detected files in a storage unit separate from the*



*vast-capacity recording medium*. Here, it appears that the Examiner is equating Pond's RAM 348 with the claimed *storage unit*. However, we can find no disclosure in Pond indicating that a list of files detected in ROM 351 is stored in RAM 348.

In Pond's only reference to RAM 348, Pond discloses "The main CPU 342 controls the overall operation of the IRD 16 by executing object code software stored in the read only memory (ROM) 351 and by both writing and reading data to and from the random access memory (RAM) 348." See col. 11, lines 17-20. There is no disclosure as to what the term "data" represents. Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities.

Accordingly, the rejection of claim 14 is deemed to be in error and should be withdrawn.

Having shown that claims 1, 10 and 14 are not anticipated by Pond, it is thus deemed that the rejection of claims 2-9, 11-13 and 15-19 is also deemed to be in error and should be withdrawn.

**C. Claim 20 was rejected under 35 U.S.C. §103(a), as rendered obvious and unpatentable, over Pond in view of van Zoest et al. (US 6,496,802) (*hereafter : Zoest*). The Applicant respectfully traverses this rejection for the following reason(s).**

Claim 20 requires that *said files contain music data and are grouped according to a one of a song title, an album a song came from, an artist who did the song or a song's genre*.

The Examiner erroneously states that Pond teaches "the files consist of entertainment data," and refers us to Pond's col. 4, lines 5-8. Looking to the cited section of Pond we find disclosed therein:

VCR, AUX and TV in the control block illustrated by reference numeral 30. These various modes of operation allow a single remote control unit to operate a multiplicity of entertainment equipment. In each of the modes . . .

We find no mention of the word "files," nor the term "entertainment data" in the cited section of Pond. A search of Pond's disclosure finds no mention of the word "files," nor the term "entertainment data." It is the job of all PTO examiner's to present factual evidence, not make up terms to suit his or her need to make a rejection.

On page 11, paragraphs 33 and 34, the Examiner states that "the terms 'file' or 'entertainment data' are logical equivalents for **ideas taught** by the Pond reference." (emphasis added).

Maybe that is what the Examiner gets from Pond, but one of ordinary skill in the art would not equate files to channels, and would not equate channel information to entertainment data.

Additionally, Pond is directed to television and in particular an on-screen guide of television channels. One of ordinary skill in the art would have no motivation to look to Zoest's teachings of *music data* for modifying Pond or even combining the teachings of Pond and Zoest.

The Examiner fails to point out why one of ordinary skill in the art would look to a teaching concerning *music data* in order to modify Pond. Instead, the Examiner refers to Zoest's teaching of separating a list into sublists if it comprises more than 250 elements. The Examiner has not identified where pond discloses a list having more than 250 elements, such that one of ordinary skill

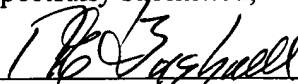
in the art, if familiar with Zoest, would look to the teachings of Zoest to modify Pond. And it is not clear how one of ordinary skill in the art of television broadcasting would be familiar with Zoest.

Accordingly, the rejection of claim 20 is deemed to be in error and should be withdrawn.

The Examiner is respectfully requested to reconsider the application, withdraw the objections and/or rejections and pass the application to issue in view of the above amendments and/or remarks.

Should a Petition for extension of time be required with the filing of this Amendent, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if, **and only if**, a petition for extension of time be required **and** a check of the requisite amount is not enclosed.

Respectfully submitted,



Robert E. Bushnell  
Attorney for Applicant  
Reg. No.: 27,774

1522 K Street, N.W.  
Washington, D.C. 20005  
(202) 408-9040

Folio: P56642  
Date: 7/21/05  
I.D.: REB/MDP